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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,236	12/06/2001	Kevin P. Baker	GNE.2830P1C12	5005
35489	7590	06/07/2004	EXAMINER	
HELLER EHRMAN WHITE & MCAULIFFE LLP 275 MIDDLEFIELD ROAD MENLO PARK, CO 94025-3506			LANDSMAN, ROBERT S	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/007,236

Applicant(s)

BAKER ET AL.

Examiner

Robert Landsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/12/02, 4/11/02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Sequence Comparison.

## DETAILED ACTION

### ***1. Formal Matters***

- A. The Preliminary Amendment dated 12/6/01 has been entered into the record.
- B. The Preliminary Amendment dated 9/9/02 has been entered into the record.
- C. The Information Disclosure Statement dated 3/12/02 has been entered into the record.
- D. The Information Disclosure Statement dated 11/4/02 has been entered into the record.
- E. Claims 28-33 are pending and are the subject of this Office Action.

### ***2. Priority***

Due to the excessive number of applications from which the present application claims benefit, priority cannot be determined. If Applicants are relying on a parent application in any argument, it is incumbent upon the applicant to provide the serial number and specific page number(s) of any parent application filed prior to the present application which specifically supports the particular claim limitation for each and every claim limitation in all the pending claims which applicant considers to have been in possession of and fully enabled for prior to 12/6/01.

### ***3. Information Disclosure Statement***

- A. References 7 and 8 on the IDS dated 11/4/02 have been lined through since they are not in proper format, including author and accession number.
- B. All references on the IDS dated 3/12/02 have been lined through since they are duplicates of the IDS dated 11/4/02.

### ***4. Specification***

- A. Though none could be found, due to the length of the specification, Applicants are reminded that embedded hyperlink and/or other form of browser-executable code are not permitted in the specification. See MPEP § 608.01.
- B. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title recites polypeptides and polynucleotides whereas the claims are drawn to antibodies.

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**5. Claim Objections**

- A. The syntax of claims 28-33 could be improved by replacing the phrase "shown in Figure 92 (SEQ ID NO:148)" in claims 28 and 33 with "of SEQ ID NO:148."

**6. Claim Rejections - 35 USC § 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- A. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not understood how an antibody can be both an "antibody" and a "fragment." The phrase "an antibody, or fragment thereof," for example, could be used in independent claim 28 and claim 31 could be cancelled.
- B. Claim 33 is confusing since it is not clear what the definition of "specifically binds" is. This term is not defined in the specification. Furthermore, it is not clear how this claim differs from that of claim 33, where the antibody "binds" the protein of SEQ ID NO:148.

**7. Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- A. Claims 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibui et al. in view of Lal et al. The claims recite an antibody which binds the protein of SEQ ID NO:148. Shibui et al. teach a protein which is 54.1% identical to SEQ ID NO:148 of the present invention (Sequence Comparison). Shibui do not teach antibodies. However, Lal teach humanized antibodies (column 9, lines 23-27), monoclonal antibodies and fragments (column 34, lines 43- column 35, line 44) and labeled antibodies (column 40, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of the present invention to have made humanized, labeled, and monoclonal antibodies to the protein of Shibui for the purpose of diagnostics (label) as well as for treatment of human diseases (humanized). Monoclonal antibodies would be desired due to their peptide specificity as compared to polyclonal antibodies.

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*18. Conclusion*

A. No claim is allowable.

*Advisory information*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.  
Patent Examiner  
Group 1600  
June 03, 2004

  
ROBERT LANDSMAN  
PATENT EXAMINER